



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/544,212	10/17/95	RUSSO	D 01222.0034

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IM62/1026

EXAMINER

BRUNSMAN, D

ART UNIT	PAPER NUMBER
1755	40

DATE MAILED: 10/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/544,212

Applicant(s)
Russo et al

Examiner
David M. Brunsmann

Group Art Unit
1755



☒ Responsive to communication(s) filed on 22 Jun 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-29, 31-60, 65, and 66 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-27 is/are allowed.

☒ Claim(s) 28, 29, 31-60, 65, and 66 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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The outstanding office action mailed 05 June 2000 is withdrawn in view of reconsideration of the issues in this reissue application. The telefax amendment filed 22 June 2000 has been entered in an attempt to expedite prosecution. Claims 1-29, 31-60, 65 and 66 are pending. The original patented claims 1-27 remain in allowable condition.

The first and second protests filed in this application have been fully considered and the issues raised therein have been prosecuted in the subsequent office actions. Each of the documents cited in the protests has been explicitly considered and made of record on a PTO-1449, Information Disclosure Statement, already present in the application file.

In view of recent court decisions on recapture such as *In re Clement*, 45 USPQ2d 1164 and others, a new rejection under recapture is required. MPEP 1412.02 sets forth office policy regarding the standards to be used in formulating a rejection under recapture in light of these new court decisions. MPEP 1412.02, example A is considered to be particularly relevant to the instant issues.

Claims 28, 29, 31-60, 65 and 66 are rejected under 35 U.S.C. 251. In the original application, broad claims were rejected for the reason that the disclosure was enabling only for claims to gaseous compositions of a particular class of silicon oxide precursors, tin oxide precursors and certain accelerants were allowed, in that only these precursors would achieve the required deposition rate of at least 350 angstroms/sec. that was explicitly taught as defining over the prior art. See columns 1-4 of the original patent. The office action specifically stated "The prior art of record fails to teach or suggest a gaseous composition comprising the recited tin oxide

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precursor, silicon oxide precursor and accelerant selected from borates, phosphites and water.”

The claims were amended to be limited to those specific materials in response to the rejection.

MPEP 1412.02 states

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

For example,

The limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

A limitation of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

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In the instant proceedings, the patentee explicitly asserted an obtained deposition rate of 350 angstroms/second as distinguishing over the prior art and states "The invention is made by CVD at rates greater than about 350 angstroms/second." This statement alone is seen as sufficient to prohibit recapture of subject matter outside compositions that do not necessarily obtain that depositions rate. Reissue claims must be limited to compositions that deposit at 350 angstroms/second. Furthermore, the claims in the patented application were specifically amended to be limited to those compositions that necessarily obtain that deposition rate. Any reissue claims limited to compositions depositing at at least 350 angstroms/second must, therefore, also be limited to the specific gaseous precursor compositions set forth in the patented claims in view of the prosecution history of the patented application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is (703) 308-3454. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays from 6:30 am to 5:00 pm eastern time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for this Group is (703) 305-3599. All communication related to the merits of the application, including the outstanding rejections, should be made in writing.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

DMBrunsman
October 12, 2000



David M. Brunsman
Primary Examiner
Group 1755